

Applicants: Elena Feinstein and Orna Mor
Serial No.: 09/825,682
Filed: April 4, 2001
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REMARKS

Claims 1-2, 4-7, and 9-29 were pending in the subject application. Applicants hereinabove have canceled claims 7, 9-23, 25, and 28-29 without disclaimer or prejudice and amended claims 1, 2, 4-6, 26, and 27. Accordingly, claims 1, 2, 4-6, 24, 26, and 27 are now pending and presented for the Examiner's consideration.

The preceding amendments were made to remove the term "polypeptide-encoding", to delete references to non-elected SEQ ID NOS., to clear up claim language, and to correct minor grammatical errors. Accordingly, the preceding amendments raise no issue of new matter and applicants respectfully request that the Amendment be entered.

In light of the amendments and remarks presented herein, applicants respectfully request favorable reconsideration of the claim rejections.

Applicants note that the documents filed on June 4, 2003, August 1, 2002 and December 2, 2002 have all been entered.

Election/Restriction

Applicants note that the election with traverse of Group I, and of SEQ ID NOS: 56, 57 and 41 is acknowledged.

Applicants note the Examiner's objection to the term *polypeptide-encoding polynucleotides*. Without conceding the correctness of the Examiner's objection, the term has been changed throughout the claims to recite simply *polynucleotides*.

Applicants note that the Examiner has deemed that the restriction requirement is proper.

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Applicants note that claims 1-2, 4-7, 9, 24 and 26-29 as amended herein now under consideration recite the combination of SEQ ID NOS 56 and 57 as well as the combination of SEQ ID NOS 56, 57 and 41.

Priority

As requested by the Examiner, the application has been amended so as to contain a specific reference to the prior application in the first sentence of the specification. Applicants believe the application now meets the requirements for obtaining the benefit of the earlier applications cited.

Information Disclosure Statement

On pages 5-7 of the June 16, 2003 Office Action, the Examiner stated that the PTO Form 1449 submitted with applicants' March 25, 2003 Communication does not properly identify each of the references present in U.S. Serial No. 09/670,672.

Applicants note that the Examiner has reviewed U.S. Serial No. 09/670,672, including the references, and that applicants are not required to provide copies of any U.S. Patents or any references that were provided in U.S. Serial No. 09/670,672.

Applicants attach hereto, as **Exhibit A**, a supplemental PTO Form 1449. Applicants would like to draw attention to the fact that neither applicants nor the undersigned have copies of most of the references listed on the PTO Form 1449 submitted with applicants' March 25, 2003 Communication. The supplemental PTO Form 1449, attached hereto, contains proper citations of all the references for which it is possible to do so. Applicants request that the Examiner provide a signed/initialed copy of the enclosed supplemental PTO Form 1449.

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Specification

The title of the invention has been amended herein as requested by the Examiner.

The reference to the trademark TAQMAN has been amended herein as requested by the Examiner.

Claim Objections

Claims 7 and 9 are objected to because of formalities. These claims have been cancelled herein and so this objection is moot.

Claim Rejections: 35 U.S.C. 112

Applicants note that claims 1-2,4-7, 9, 24 and 26-29 are rejected by the Examiner under 35 U.S.C. 112, first paragraph, as being unduly broad. This is discussed in detail on pages 7-10 of the Office Action.

However, the Examiner notes (foot of page 10) that "...one of skill in the art could clearly practice methods of diagnosing bladder cancer /bladder TCC in which increased expression of SEQ ID Nos 56 and 57, alone or in combination with SEQ ID NO: 41, ...".

All the pending claims as currently amended (claims 1, 2, 4-6, 24, 26 and 27) relate to methods of diagnosing bladder cancer using polynucleotides which include sequences corresponding to SEQ ID NOS. 56, 57 and 41. Applicants therefore believe the pending claims now meet the Examiner's requirements under 35 U.S.C. 112, first paragraph, and respectfully request withdrawal of the ground of rejection, and allowance of the claims.

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Applicants note that claims 1-2,4-7, 9, 24 and 26-29 are rejected by the Examiner under 35 U.S.C. 112, second paragraph, as being indefinite.

First, the Examiner notes that independent claims 1, 7 and 9 do not previously refer to "polynucleotides having sequences represented by". Claim 7 and 9 have been cancelled, and the language in claim 1 has been amended for clarity and to overcome the rejection based on indefiniteness.

The Examiner notes that claim 5 is indefinite over the recitation of the limitations "the analyzing step" and "the step of using RT-PCR technology" because of insufficient antecedent basis. In response, claim 5 has been amended, as set forth above.

The Examiner notes that claim 6 is indefinite over the recitation of the limitations "the analyzing step" and "the step of using a specific antibody..." because of insufficient antecedent basis. In response, claim 6 has been amended, as set forth above.

The Examiner further notes that claim 6 is indefinite because it is unclear as to how the claim is intended to further limit claim 1. The Examiner states that it "is unclear as to whether the instant claim is intended to require detection of a polypeptide as an indicator of polynucleotide levels, "...or whether this language is intended to require a step to be performed in addition to polynucleotide detection". In response, claim 6 has been amended to recite "consisting essentially" language.

Applicants believe that the amendments to claims 5 and 6 render these claims definite under 35 U.S.C. 112, second paragraph.

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In conclusion, based on the arguments presented above, Applicants respectfully request re-consideration of the claim rejections as recited in the June 16, 2003 Office Action and allowance of the new pending claims.

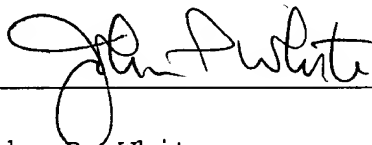
Summary

For the reasons set forth hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the various grounds of objection and rejection set forth in the June 16, 2003 Office Action and earnestly solicit allowance of the now pending claims, i.e. claims 1, 2, 4-7, 9, 24, 26, and 27 as amended.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

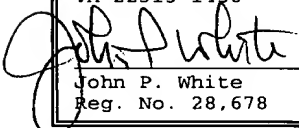
No fee is deemed necessary in connection with the filing of this Amendment. However, if any other fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450



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1/9/04
Date